

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

Appl. No. : 10/552,808

Applicant(s): Bernhard Gleich

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TC/A.U.: 3700/3768

Examiner: Vani Gupta

Atty. Docket: DE 030124 US1

Confirmation No.: 5527

Title: DEVICE AND METHOD FOR EXAMINATION AND USE OF AN
ELECTRICAL FIELD IN AN OBJECT UNDER EXAMINATION
CONTAINING MAGNETIC PARTICLES

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed on **January 5, 2011**, Applicants provide herewith a timely filed Reply Brief.

This paper includes (each beginning on a separate sheet):

1. Remarks/Discussion of Issues;

1. REMARKS / DISCUSSION OF ISSUES

In response to the Examiner's Answer, Applicants present this Reply Brief. The Reply Brief responds to section (10) of the Examiner's Answer, "Response to Argument." Applicants position stated in the Appeal Brief is maintained, and the Reply Brief supplements the Appeal Brief.

I. *Wang, et al.* fails to disclose at least a transmit and/or receive unit comprising a voltage source

Applicants' put forth their position in the Appeal Brief that *Wang, et al.* fails to disclose at least a ***transmit and/or receive unit*** comprising a voltage source, as specifically recited in claim 1. The Examiner disagrees and asserts "...that the transmit and/or receive unit structure of Wang et al. itself is the excitation source that applies voltage or current to one or more electrical contacts (2) connected to the unit. That is, the excitation source is the ring of the transmit/receive unit of Wang (Figure 1). The contacts (2) are connected to, or surround, the ring[.]"

At the outset, Applicants respectfully note that the Examiner's Answer fails to direct them to any aspect of *Wang, et al.* for the alleged disclosure of the transmit and/or receive unit. Rather, the Examiner's Answer asserts that the ring 1 is the excitation source of the transmit and/or receive unit, with no explicit reference to what allegedly constitutes the transmit and/or receive unit.

Applicants respectfully submit that there is no disclosure in Fig. 1 of *Wang, et al.* of a transmit and/or receive unit comprising a voltage source as specifically recited in claim 1. Fig. 1 of *Wang, et al.* is described at column 4, line 61 through column 5, line 23. At column 4, lines 61-65, *Wang, et al.* discloses:

"The electrically conductive ring sensor basically consists of an electrically conductive ring 1, a number of electrical contacts 2, a target content 3, a number of electrical excitation sources 4 and a number of voltage measurement devices 5 [FIG. 1]."

Plainly, there is no disclosure of a transmit and/or receive unit in Fig. 1 of *Wang, et al.*, and especially no disclosure of a transmit and/or receive unit comprising a **voltage source**.

II. Certain aspects of the grounds of rejection are not based in law

At page 7, the Examiner's Answer states:

"Furthermore, Applicant has not claimed any actual function that the transmit and/or receive unit must perform to make it patentably distinct over the prior art. The claim as it is written claims that there is some "kind" of unit that comprises a voltage source or generator (the ring indicated in Figure 1)..."

Applicants again note that the plain language of claim 1 positively recites a transmit and/or receive unit. Applicants maintain that there is no disclosure of a transmit and/or receive unit in *Wang, et al.* rendering the rejection deficient. Applicants further note that a *prima facie* case of obviousness requires, inter alia, the prior art reference or combination of references must teach or suggest all the limitations of the claims.¹ It follows that if a reference does not teach or suggest all the limitations of a claim a *prima facie* case of obviousness cannot be established. There is no requirement that Applicants must recite functional language to further distinguish the claimed subject matter over the applied art when the art does not disclose a positively recited element of a claim.

III. Claim 3 features a ground terminal applicable and/or fastenable to an object under examination

At page 7, the Examiner's Answer asserts:

"First of all the claim language does not specify that the ground terminal must be connected to the object, but rather that it is applicable and/or fastenable to an object under examination. Therefore, the claim language is broad enough to encompass either the

¹ See *In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.").

connection of the ground terminal to the patient or the application of the ground terminal within the vicinity of the patient.”

Applicants respectfully submit that that the broad interpretation that the ground terminal is applicable within the vicinity of the patient is not reasonable in view of the specification as filed. Notably, ground terminal 20 is shown in Fig. 2. The voltage present between signal terminal contact 18 and ground terminal contact is detected by means of a voltage measuring apparatus. The ground terminal contact 20 is clearly shown in contact, and **not merely in vicinity of the patient**. Applicants respectfully submit that no reasonable review of the specification would reach the understanding that the ground terminal contact is merely in the vicinity of the patient.

IV. Objective evidence is not provided in the rejection

The Examiner’s Answer directs Applicants to a dictionary definition of a “ground” and asserts that certain aspects of a ground are commonly known to one of ordinary skill in the art. Yet, no **objective evidence** of record is presented to support the assertions set forth at page 8 of the Examiner’s Answer. Rather, the Examiner’s assertions are subjective and reference no authority.

Conclusion

In view the foregoing, applicant(s) respectfully request(s) withdrawal of the objection(s) and/or rejection(s) of record, allowance all the pending claims, and finding of the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:
Phillips Electronics North America Corp.

/William S. Francos/

by: William S. Francos (Reg. No. 38,456)

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